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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/639,908

Filing Date: August 16, 2000

Appellant(s): JOAO, RAYMOND ANTHONY

Raymond A. Joao
For Appellant

SUBSEQUENT EXAMINER'S ANSWER

This is in response to the substitute appeal brief filed 3/27/2006 appealing from the Office action mailed 6/2/2004. The Examiner's Answer dated 2/24/2005 has been vacated.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is deficient. 37 CFR 41.37(c)(1)(v) requires the summary of claimed subject matter to include: (1) a concise explanation of the subject matter defined in each of the independent claims involved in the

appeal, referring to the specification by page and line number, and to the drawing, if any, by reference characters and (2) for each independent claim involved in the appeal and for each dependent claim argued separately, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters. The brief is deficient because the invention is directed to a computer implemented expert securities portfolio investment management system which operates as a registered investment advisor. The system automatically defines personal customer objectives, designs individualized investment portfolios, adjusts portfolios for economic environment, researches and selects specific securities, evaluates and determines the proper time to buy and sell customer securities, generates orders to buy and sell customer securities, generates orders to buy and sell customer securities, updates customer account information and provides tax and performance reports. Research data and personal account information are updates on a timely, periodic basis.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,018,722

RAY et al.

1-2000

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 42, 61-66, 68-71, 73-79, 81-89, and 91-104 are rejected under 35 U.S.C. 102(e) as being anticipated by Ray et al. (US 6,018,722 A).

Regarding independent claim 42, Ray et al. disclose an apparatus for providing financial information and investment information to an investor comprising a receiver (col. 3, lines 4 – 35; and figure 2, the receiver being a component of the base station grouping and CPU 245 and hub 215); wherein the receiver receives a request to receive information regarding a change in at least one economic, fundamental technical or risk/return factor and information regarding a correlation of the least one factor with at least one of a variety of different types of securities. All of the factors mentioned in Ray

et al. are correlated to the performance of securities (col.. 2, lines 20 - 40). Ray et al. further disclose a processor (see figure 2, a component of base station grouping and CPU 245 and hub computer 215) detecting the change in the factor, processing the request and generating at least one of a signal, a message, and a report for transmission by transmitter (figure 2, component of base station grouping) to the communication device 210 of the investor (col.. 3, lines 4 - 35).

Regarding independent claim 68, refer to the section above concerning claim 42. Additionally, Ray et al. disclose a database (a component of base station grouping and CPU 245 and hub computer 215) for storing the data about the correlated factor for at least some increment of time (col.. 10, lines 55- 65). Ray et al. disclose first communication device 210. It is the opinion of the examiner that the second communication device of applicant's claim 68 has not been positively claimed by the current claim language.

Regarding independent claim 73, refer to the section above concerning claim 42 and see col. 3, lines 4-35; figure 2, the receiver being a component of the base station grouping and CPU 245 and hub 215; col. 2 lines 20-40.

Regarding independent claim 83, refer to the section above concerning claim 42 and see col. 3, lines 4-35; figure 2, the receiver being a component of the base station grouping and CPU 245 and hub 215; col. 2 lines 20-40. Additionally, Ray et al. disclose that the processor of the expert system can perform a transaction on he part of the investor (col.. 9, lines 28 - 43).

Regarding independent claim 94, refer to the section above concerning claim 42 and see col. 3, lines 4-35; figure 2, the receiver being a component of the base station grouping and CPU 245 and hub 215; col. 2 lines 20-40. The communication device 210 is a display device.

Regarding claims 61, 62, see the section on claim 42 above and see col. 3, lines 4-35; figure 2, the receiver being a component of the base station grouping and CPU 245 and hub 215; col. 2 lines 20-40.

Regarding claim 63, see the section on claim 68 above, the receiver being a component of the base station grouping and CPU 245 and hub 215, and col. 10, lines 55-65.

Regarding claim 64, Ray et al. disclose the online computer services 230 (fig. 2).

Regarding claim 65, Ray et al. disclose research and investment recommendations (col. 3, lines 12-35 and col. 9, lines 29 - 43).

Regarding claim 66, Ray et al. disclose electronic transmission or fax modem transmission of the signal, message or report (col. 3, lines 4 -11).

Regarding claim 69, see the section above on claim 64 and figure 2.

Regarding claim 70, Ray et al. disclose research and investment recommendations (col. 3, lines 12-35 and col. 9, lines 29 - 43).

Regarding claim 71, see the section above on claim 66 and see col. 3, lines 4 -11.

Regarding claim 74, see the section above on claim 42 and see col. 3, lines 4-35; figure 2, the receiver being a component of the base station grouping and CPU 245 and hub 215; col. 2 lines 20-40.

Regarding claim 75, Ray et al. disclose the communication device 210.

Regarding claim 76, see the section above on claim 68 and the receiver being a component of the base station grouping and CPU 245 and hub 215 and col. 10 lines 55-65.

Regarding claim 77, Ray et al. disclose the online computer services 230 (fig. 2).

Regarding claim 78, Ray et al. disclose research and investment recommendations (col. 3, lines 12-35 and col. 9, lines 29 - 43).

Regarding claim 79, Ray et al. disclose electronic transmission or fax modem transmission of the signal, message or report (col. 3, lines 4-11).

Regarding claim 81, Ray et al. disclose online computer services 230.

Regarding claim 84, see the section on claim 42 above and see col. 3, lines 4-35; figure 2, the receiver being a component of the base station grouping and CPU 245 and hub 215; col. 2 lines 20-40.

Regarding claim 85, Ray et al. disclose the communication device 210.

Regarding claim 86, Ray et al. disclose a database (a component of base station grouping and CPU 245 and hub computer 215) for storing the data about the correlated factor for at least some increment of time (col. 10, lines 55 - 65).

Regarding claim 87, Ray et al. disclose online computer services 230.

Regarding claims 88, 89, 92, 95, 96, 97, 98, the limitations therein have been discussed above and see col. 3, lines 4-35; figure 2, the receiver being a component of the base station grouping and CPU 245 and hub 215; col. 2 lines 20-40.

Regarding claim 91 and 99, Ray et al. discloses that the advisor expert system can execute the recommended transactions on behalf of the investor. Legally binding authorizations

for such transactions, while not specifically mentioned, are inherent in the Ray et al. disclosure (col.. 9, lines 9 - 43).

Regarding claim 93, Ray et al. discloses the generation of order confirmations and the updating of account assets (col.. 9, lines 22 - 28).

Regarding claim 100, see the section above on claim 94 in addition, refer to the section above concerning claim 42 and see col. 3, lines 4-35; figure 2, the receiver being a component of the base station grouping and CPU 245 and hub 215; col. 2 lines 20-40. The communication device 210 is a display device..

Regarding claim 101, see the section on claim 42 above and see col. 3, lines 4-35; figure 2, the receiver being a component of the base station grouping and CPU 245 and hub 215; col. 2 lines 20-40.

Regarding claim 102, refer to the section above concerning claim 42. Additionally, Ray et al. disclose a database (a component of base station grouping and CPU 245 and hub computer 215) for storing the data about the correlated factor for at least some increment of time (col.. 10, lines 55- 65). Ray et al. disclose first communication device 210. It is the opinion of the examiner that the second communication device of applicant's claim 68 has not been positively claimed by the current claim language.

Regarding claim 103, refer to the section above concerning claim 42 and see col. 3, lines 4-35; figure 2, the receiver being a component of the base station grouping and CPU 245 and hub 215; col. 2 lines 20-40.

Regarding claim 104, refer to the section above concerning claim 42 and see col. 3, lines 4-35; figure 2, the receiver being a component of the base station grouping and CPU 245 and hub

215; col. 2 lines 20-40. Additionally, Ray et al. disclose that the processor of the expert system can perform a transaction on the part of the investor (col. 9, lines 28 - 43).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 82 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ray et al. (US 6,018,722).

Ray et al. does not specifically disclose that the report of advisor expert system contain information regarding at least one of a patent grant and insider trading activity. However patent grant and insider trading activity are well known events that are researched in the fundamental analysis of any equity and the examiner takes official notice of this fact. It would have been obvious, in view of this official notice, to one of ordinary skill in the art of fundamental analysis, to provide patent grant and/ or insider trading activity information in the Ray et al. research

reports displayed to the investor, so as to enable the investor to be aware of these factors that could potentially impact the valuation of the equity.

(10) Response to Argument

The entire brief is a conclusion of what Ray et al. does not disclose but provides no rationale as to why the Examiner's citation of Ray et al. is incorrect.

Appellant's allegation that the applied reference fails to teach the claimed limitation of the features of claims 42, 61-66, 68-71, 73-79, 81-89, 91-100 is respectfully submitted to be without merit. In particular, the Examiner respectfully submits that the Ray et al. reference teaches the disputed features. Note, for example, col. 3, lines 4-35, col. 10, lines 55-65, col. 9 lines 28-43, col. 2, line 20-40, fig. 2, the receiver being a component of the base station grouping and CPU 245 and hub 215 and communication device 210 is the display device of the Ray et al. reference. Appellant's allegations that the Ray et al. reference fails to teach the aforementioned feature are merely conclusory and are not supported by any evidence provided by Appellant which clearly and definitely call into question the cited passages of the applied reference. Appellant has apparently failed to provide any reasonable analysis of the applied reference. Thus, it is respectfully submitted that Appellant's conclusions cannot take the place of evidence. *In re Cole*, 51 CCPA 919, 326 F.2d 769, 140 USPQ 230 (1964); *In re Schulze*, 52 CCPA 1422, 346 F.2d 600, 145 USPQ 716 (1965); *Mertizner v. Mindick*, 549 F.2d 775, 193 USPQ 17 (CCPA 1977).

With regards to the arguments against the rejection of claim 82, to adequately traverse such a finding, an applicant must specifically point out the supposed errors in the examiner's

action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. A general allegation that the claims define a patentable invention without any reference to the examiner's assertion of official notice is an inadequate traversal. The common knowledge or well-known in the art statement is taken to be admitted prior art because applicant failed to traverse the examiner's assertion of official notice.

It is noted that applicant has provided a conclusion but has not provided any arguments why the cited passages do not meet any of the claim limitations.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Kelly S Campen/

Conferees:

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TC 3600

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